Withdrawal of Final Rejection

Applicant respectfully requests the Examiner to withdraw the Final Rejection pursuant to MPEP §706.07(e), based on the following showing under 37 C.F.R. §1.116(b) or in the alternative, as premature.

In the Final Office Action, mailed August 4, 1994, the Examiner stated in paragraph 4 (top of page 4) that Claims 1-20 and 23 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112. The rejections of Claims 1-20 and 23 were all based on 35 U.S.C. §112, second paragraph. Applicant filed an amendment addressing these rejections on November 3, 1994.

However, during the Examiner Interview, the Examiner stated new grounds of rejection based on 35 U.S.C. §112, first paragraph. Thus, the present amendment is necessary to address the Examiner's new ground of rejection and could not have been presented earlier because the Examiner did not provide this new ground of rejection until the Examiner Interview.

Moreover, MPEP § 706.07 entitled "Final Rejection" states:

> "Before final rejection is in order a clear issue should be developed between the Examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection."

Here, Applicant respectfully submits the final rejection is premature. The Applicant responded to the 35 U.S.C. § 112, second paragraph rejection by amending the claims in good faith only to have the Examiner then assert a 35 U.S.C. 112, first paragraph rejection against the Applicant. Applicant respectfully submits that in accordance with the spirit and language of § 706.07 of the MPEP, the Examiner should have recognized both of these alleged indefinitenesses in the

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initial review of the Amendment filed May 4, 1994, and required correction under both 35 U.S.C. 112, first paragraph and second paragraph in the same Office Action. Applicant believes that the final rejection therefore is premature and should be withdrawn at this time. Applicant in good faith amended the claims to overcome the 35 U.S.C. 112, second paragraph rejection and believed, in view of the Examiner's comment in paragraph 4 of the Final Office Action that "Claims 1-20 and 23 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112." This Applicant has done. For the Examiner now to allege a different 35 U.S.C. 112, indefiniteness rejection and not to withdraw the final rejection Applicant believes is premature. If the Examiner does not withdraw the final rejection Applicant will have no choice but to petition to the Commissioner for redress.

Objection to the Drawings

Applicant notes the Examiner's objections and will correct the discrepancies in the Formal drawings.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1-23 are rejected under 35 U.S.C. §112, second paragraph for indefiniteness. The Examiner has cited specific language in Claims 1, 14, 16 and 23 as indefinite. Claims 1, 14, 16 and 23 are amended to be more definite. Specifically, Claim 1 is amended to recite in pertinent part:

> power control means for supplying a variable voltage to said memory integrated circuit without varying a voltage being supplied to elements of said electronic system other than said memory integrated circuit (emphasis added)

The phrase "the portions" is replaced with --elements--, and the phrase "independently from the" was replaced with --without varying a--.

This new language is fully supported in the specification

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and drawings. For example, Figure 1 shows an embodiment of a dynamic power management device according to Claim 1. Figure 1 clearly shows that the VCC input of DRAM 13 is coupled only to power director 29 (through low pass filter 31). Consequently, power director 29 can vary the voltage supplied to DRAM 13 without varying the voltage supplied to the rest of the electronic system in which the power management device and DRAM is embedded. Accordingly, Applicant believes that Claim 1 is now fully compliant with 35 U.S.C. §112, first and second paragraphs.

Claim 23

In the Advisory Action mailed November 17, 1994, the Examiner did not enter Applicant's amendment to independent Claim 23 which Applicant believes overcomes the Examiner's 35 U.S.C. §112, second paragraph rejections. However, the Examiner did not provide any reason for not entering the amendment to Claim 23. Because the Examiner had stated in the Final Office Action mailed August 4, 1994 that Claim 23 would be allowable if rewritten to overcome 35 U.S.C. §112 rejections, applicant believes Claim 23 is allowable.

Conclusion

Claims 1-20 and 23 are now pending. Claims 1, 14, 16 and 23 are amended. No new matter is added. For the reasons presented above, Applicant believes that Claims 1-20 and 23 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

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If the Examiner's next action is other than allowance of Claims 1-20 and 23, the Examiner is respectfully requested to call Applicant's attorney at (408) 283-1222.

Respectfully submitted,

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

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